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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,660	03/06/2006	Eleanor Keogh	050026-0028	1225

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
DOAN, ROBYN KIEU	
ART UNIT	PAPER NUMBER
3732	
MAIL DATE	DELIVERY MODE
07/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/570,660	KEOGH, ELEANOR	
	Examiner	Art Unit	
	Robyn Doan	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response filed 4/16/09 has been entered and carefully considered. Arguments regarding the 35 U.S.C. 103 (a) have not been found to be persuasive, therefore, claims 1-20 are rejected under the same ground rejections as set forth in the office action mailed 1/16/09.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 5-13, 15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrell (USP 5,065,778) in view of Masterson (USP 4,020,856).

Terrell discloses a nail polish removing device (fig. 2) comprising a container (21) including a nail polish removing solution compartment (27) in a bottom part thereof, an opening (36) adapted to receive a portion of a foot to be cleaned in a lateral manner, a porous and pliable medium (43) disposed in the container at least partly above the solution compartment (see fig. 2) and in contact with the solution (when the container is inverted col. 3, lines 33-38); the solution at least partly permeates the porous member, the porous having a slot (36-40) adapted to receive a portion of the foot, the slot disposed in alignment with the opening (see fig. 3), a cover (31) for sealing the compartment (27) against a loss of the solution; the solution is uniformly absorbed in the

porous member by a combination of agitation (when the container is inverted) and capillary action; The container being made of plastic (col. 2, lines 40, 41) and the porous being a sponge (col. 3, line 15). The device is inherently can be use to remove nail polish from toes. Terrell fails to show the opening of the container located on a side wall. Masterson discloses a fingernail and hand cleaning device having a container (12) with a side wall (fig. 1), wherein the side wall having an opening (24) for inserting the fingernail or hand to be cleanse. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the opening on the side wall of the container as taught by Masterson into the device of Terrell as an alternative way of providing an easy way to insert the finger or hand into the container of the device.

Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrel in view of Masterson as applied to claims 1 and 10 above, and further in view of Miller (USP 4,510,954).

Terrell in view of Masterson disclose the essential claimed invention except for the container further having a ledge disposed at bottom of the opening. Miller discloses a fingernail polish remover (fig. 3) comprising a container (12) having an opening (26), a ledge (32) disposed at bottom of the opening. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the ledge as taught by miller into the device of Terrell in view of Masterson in order to provide a finger's rest to the device.

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrel in view of Masterson as applied to claims 1 and 10 above, and further in view of Gary et al (USP 6,695,800).

Terrell in view of Masterson disclose the essential claimed invention except for the container further having non-skid means. Gary et al discloses a hand treatment device (fig. 10) comprising a non-skid means (234). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the non-skid means as taught by Gary et al into the device of Terrell in view of Masterson in order to enhance attachment to the device.

Response to Arguments

Applicant has argued that the scrubbing member (43) of Terrell is not in contact with the solution, however, in col. 3, lines 35-38, Terrell does teach the inner walls of scrubbing member (43) allow the liquid to pass through when the device being inverted; therefore, it meets the claimed limitations. Applicant has further argued that the term “in contact” cannot be equated with “in contact, when inverted”. Applicant is noted that Terrell has shown the device being in contact with the solution and whether it is inverted or not is irrelevant because Terrell has shown the claimed structures.

Applicant has further argued that Masterson does not suggest a porous medium and Masterson and Terrell are very dissimilar in their structure. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Masterson teaches it is known in the art to have a fingernail cleaning device comprising a container (12) with a side wall (fig. 1), wherein the side wall having an opening (24) for inserting the fingernail or hand to be cleanse, therefore, it is proper to modify the side wall of Terrell with an opening as taught by Masterson as an alternative way of providing an easy way to insert the finger or hand into the container of the device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732